Appl. No. 09/474,317
Amdt. dated August 19, 2004
Reply to Office Action of February 19, 2004

PATENT

REMARKS/ARGUMENTS

Claims 1-27 are pending. Claim 17 has been amended. Claim 27 has been added. Support for the new and amended claims can be found in the specification. No new matter has been added.

Claims 1-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent to Gabbard et al. ("Gabbard") and in view of U.S. patent 6,101,531 to Eggleston et al. ("Eggleston").

Reconsideration and allowance of the claims are respectfully requested in light of the following remarks.

COMBINATION OF CITED REFERENCES FALL SHORT AND TEACH AWAY

Applicant submit that even if Gabbard and Eggleston where combined, and there is no clear suggestion to do this (see discussion below), the resultant combination would still fall short of the present invention as claimed. For example, claim 1 recites "sending the received packets unaltered to a next Internet leg in the transmission path of the file." The cited references do not teach or suggest this feature. For example, a passage at col. 12, lines 7-13 of Gabbard does not stand for the proposition that Gabbard discusses this claimed feature. The cited passage merely describes searching the message for the text "MIME-Version," in a header field. If the messages is not in a MIME format, it is checked for attachments included within the text of the message converted into a MIME format.

One should not conclude that "one [of] ordinary skill in the art [at] the time of the invention can interpret the searching [for] the MIME id in the header and not changing the format of the message on finding the id to the unaltered retransmission of the [d]igital file." (Office Action: p. 9, paragraph no. 18). On the contrary, it is clear that the message in Gabbard, regardless of its initial format, always has a background reference inserted in step 512 (Gabbard: col. 12, 41-49). In other words, according to Gabbard, unlike the present invention, the received message is necessarily altered before it is retransmitted. These facts are made plain in Fig. 10 of Gabbard. In Fig. 10, a flow of a message through the flow diagram will include step 512, where

the original message is altered. Furthermore, Figs. 4 and 5 also show the original message being altered in steps 314 and 418, respectively.

Eggleston, cited for allegedly disclosing recording the Internet Protocol header source address for each of the packets containing said specific identifying indicia, does not cure the deficiencies of Gabbard. In fact, Eggleston is a filter which teaches away from the present invention. Messages that fail a criteria in Eggleston based on filter attributes are either rejected or truncated (Eggleston: col. 8, lines 22-63), and thus are not sent "unaltered to a next Internet leg in the transmission path of the file."

Furthermore, Eggleston fails to discuss "recording the Internet Protocol header source address for each of the packets containing said specific identifying indicia" as suggested by examiner. The passages cited by examiner in no way suggests recording the Internet Protocol header source address for each message containing a specific identifying indicia. The Internet Protocol header source address is not an "user-definable filter attribute" as discussed by Eggleston.

With respect to claims 3, 18, 19, and 27, the combination of cited references do not discuss transmitting to a proprietor of the file. Eggleston filters incoming messages for a receiving user; but, it does not send Internet Protocol header source header address and identifying indicia to a proprietor or third user or, for that matter, even back to the sending user of the message. The passages cited by examiner relate to an optimized reply initiated by the receiving user to the sending user (in other words, processing based on a different set of packets constituting segments of a different file traveling in the opposite direction).

COMBINATION UNSATISFACTORY FOR CITED REFERENCES' INTENDED PURPOSE

The proposed combination of Gabbard and Eggleston could not send received packets unaltered to a next Internet leg in the transmission path of the file, and function for their intended purpose. The intended purpose of Gabbard is "inserting into an end user communication message a background reference to an advertisement." (Gabbard: abstract). The intended purpose of Eggleston is to filter messages, and thus "only desired data transfers (i.e., those meeting user defined filters) are communicated over the expense-bearing networks

between the remote unit and communication server." (Eggleston: Abstract). In either case, a received message with specific identifying indicia is altered. Gabbard will insert a background advertisement and Eggleston will filter or truncate message. Therefore, neither Gabbard nor Eggleston could perform as intended.

NO SUGGESTION TO COMBINE THE CITED REFERENCES

Applicant respectfully submits there is no motivation to combine Eggleston with Gabbard. The examiner has not pointed to any "clear and particular" suggestion or motivation to combine the references.

The motivation articulated by examiner of reduced latency is inapposite to the results of the proposed combination. For example, Gabbard would clearly require additional processing resources/time to record "the Internet Protocol header source address for each of the packets containing said specific identifying indicia," which it did not do previously. Performing this additional recording process could only increase latency, not reduce it as suggested by the examiner.

In addition, there is no explanation how Gabbard, as modified by Eggleston, provides more security. Nowhere does Gabbard discuss or suggest security or use the words "security" or "secure."

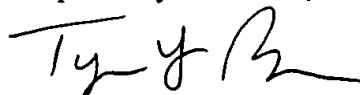Therefore, claims 1-27 should be allowed for at least the reasons discussed above.

CONCLUSION

In view of the foregoing, applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400, extension 5434.

Respectfully submitted,

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